



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/672,556

09/25/2003

Dennis M. DiVenuta

9392-2

8847

20792 7590 11/05/2008
MYERS BIGEL SIBLEY & SAJOVEC
PO BOX 37428
RALEIGH, NC 27627

EXAMINER

GAUTHIER, GERALD

ART UNIT

PAPER NUMBER

2614

MAIL DATE

DELIVERY MODE

11/05/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/672,556	Applicant(s) DIVENUTA ET AL.	
	Examiner Gerald Gauthier	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-111 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 50,79,97-101 and 109-111 is/are allowed.
- 6) ☒ Claim(s) 1-46,48,51,52,57-64-75,77,80,81,85-96 and 102-108 is/are rejected.
- 7) ☒ Claim(s) 47,49,53-56,76,78 and 82-84 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **Claims 20 and 60** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 20 and 60 are single step claims therefore fails to comply with the enablement requirement. MPEP 2164.08 (a).

Claims 21-29, 31-39, 61-64 and 66-73 are rejected under 35 U.S.C. 112, first paragraph because they are dependent of claims 20 and 60 above.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 60 and 65 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. "The computer-readable program code" is a software and is not patentable.

Claims 61-64, 66-73, 102-106 are rejected under 35 U.S.C. 101 because they are dependent of claims 60 and 65 above.

Claims 1-39 and 87-96 under 35 U.S.C. 101 because they are method claims run by the software claims 60 and 65 above.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 1-6, 8, 11, 12, 17-26, 28, 31, 32, 36-46, 48, 51, 52, 57-61, 63, 66, 67, 71-75, 77, 80, 81, 85 and 86** are rejected under 35 U.S.C. 102(e) as being anticipated by Garcia (US 6,680,999 B1).

Regarding **claims 1, 20, 40, 60 and 74**, Garcia discloses a method for processing prescriptions [column 1, lines 12-14] comprising:

answering a telephone call from a caller [At step 210, an incoming audio communication is received. The audio communication may come in a telephone call via a telecommunications network 354, column 3, lines 28-43];

accepting identification of a pharmaceutical prescription from the caller [if system 300 has a single pharmacy database, then a prescription number would be sufficient to uniquely identify a patient, column 3, lines 28-43];

querying at least one database using predefined criteria based on the identification of a pharmaceutical prescription to identify a targeted message [if system 300 has a single pharmacy database, then a prescription number would be sufficient to uniquely identify a patient, column 4, lines 3-11]; and

playing the targeted message to the caller [The system 300 provides an output to the caller which is representative of the requested portion of information, column 4, lines 3-11].

Regarding **claims 2, 21, 41, 51, 61 and 75**, Garcia discloses a method wherein the playing is followed by executing a refill call flow for the pharmaceutical prescription [column 3, lines 28-43].

Regarding **claims 3, 22, 42 and 52**, Garcia discloses a method wherein the querying comprises querying at least one database using the predefined criteria based on the identification of a pharmaceutical prescription to identify a series of targeted messages [column 4, lines 3-11]; and

wherein the playing comprises playing a succeeding one of the series of targeted messages to the caller in response to receipt of a caller response to a preceding one of the series of targeted messages [column 4, lines 3-11].

Regarding **claims 4, 23, 43, 63 and 77**, Garcia discloses a method further comprising: receiving a caller response to the targeted message [column 4, lines 3-11].

Regarding **claims 5, 24 and 44**, Garcia discloses a method further comprising logging the caller response [column 4, lines 3-11].

Regarding **claims 6, 25, 26, 45, 46 and 66**, Garcia discloses a method further comprising instructing the pharmacy to perform an action in response to the caller response to the targeted message [column 4, lines 3-11].

Regarding **claims 8, 28, 67 and 81**, Garcia discloses a method wherein the predefined criteria based on the identification of a pharmaceutical prescription do not include a personal identification of a patient who is using the pharmaceutical prescription [column 3, lines 3-11].

Regarding **claims 11, 3, 71, 80 and 51**, Garcia discloses a method wherein the querying comprises querying at least one database using the predefined criteria based on the identification of the pharmaceutical prescription to identify an educational targeted message concerning the pharmaceutical prescription [column 4, lines 3-11].

Regarding **claims 12, 32, 52, 72 and 85**, Garcia discloses a method wherein the querying comprises: querying at least one database using predefined criteria of last fill

date and days supply on last fill date based on the identification of a pharmaceutical prescription [column 4, lines 3-11]; and

identifying an educational targeted message that reminds the caller how to use the pharmaceutical prescription if the last fill date is less than a first threshold and the days supply on last fill date is greater than a second threshold [column 3, lines 3-11].

Regarding **claims 17, 18, 37, 48, 58 and 57**, Garcia discloses a method wherein the querying comprises: querying at least one pharmacy dispensing system database using the identification of the pharmaceutical prescription to identify the predetermined criteria [column 3, lines 28-43]; and

querying at least one message database using the predetermined criteria to identify a targeted message [column 3, lines 28-43].

Regarding **claims 19, 39 and 59**, Garcia discloses a method wherein the identification of a pharmaceutical prescription is an Rx number [column 3, lines 28-43].

Regarding **claims 36, 73 and 86**, Garcia discloses a method wherein the querying comprises: querying at least one database using predefined criteria of a patient who is using the pharmaceutical prescription that is based on the identification of a pharmaceutical prescription [column 3, lines 28-43]; and

identifying a targeted message that solicits participation of the patient in a study related to the pharmaceutical prescription if the age of the patient qualifies the patient to

Art Unit: 2614

participate in the study related to the pharmaceutical prescription [column 3, lines 28-43].

Regarding **claims 38, 46, 54**, Garcia discloses a method wherein the querying comprises: querying at least one pharmacy dispensing system database using the identification of the pharmaceutical prescription to identify the predetermined criteria [column 3, lines 28-43]; and

identifying at least one message database using the predetermined criteria to identify a targeted message [column 3, lines 28-43].

Allowable Subject Matter

6. **Claims 50, 79, 97-101 and 109-111** are allowed.
7. **Claims 47, 49, 53-56, 76, 78 and 82-84** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments with respect to **claims 1-9, 11-29, 31-49, 51-64, 66-78 and 80-111** have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (571) 272-7539. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2614

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gerald Gauthier/
Primary Examiner, Art Unit 2614

/GG/
November 4, 2008